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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,297	06/10/2005	Ryohei Koyama	Q88357	1539
23373 7590 03/25/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
COLE, ELIZABETH M				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,297

Applicant(s)

KOYAMA ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pate et al, U.S. Patent NO. 5,364,681. Pate discloses an acoustic laminate comprising a fabric backing layer, a discontinuous film layer which is breathable and a woven fabric layer. The woven fabric layer has a decorative surface. See col. 4, lines 5-17. Both the fabric backing and the woven face layer have an open structure and are therefore breathable. See col. 1, line 56 – col. 2, line 30 and col. 2, line 56 – col. 3, line 2. Pate et al does not disclose the interfacial bond strength between the film and the decorative layer. However, Pate et al discloses the same structure of an apertured film disposed between two breathable layers wherein one of the layers has a decorative surface. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112- 2112.02.

3. Pate et al differs from the claimed invention because it does not disclose the size of the apertures. However, Pate et al teaches that the openings are formed in the film by heating the film and then passing the laminate through rollers which exert heat and

pressure onto the layers. Pate et al teaches that the voids should be controlled so that they are less than 30 percent of the area of the laminate. See col. 5, line 6 – col. 6, line 13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the size and number of apertures through the process of routine experimentation by controlling the temperature and pressure exerted by the rollers in order to arrive at a laminate having the desired opening size and number.

4. Applicant's arguments filed 1/2/08 have been fully considered but they are not persuasive. Applicant argues that although Pate does teach that the film layer is discontinuous and comprises apertures, it does not teach controlling the size and permeability of the apertures because the process of the film melting is a random process. However, Pate teaches at col. 2, line 65, col.3, line 2 that during the lamination the binder becomes discontinuous to allow air and moisture to pass through and permeate the lamina. Pate further teaches at col. 3, lines 3-15 that the open area of the fabric is from 40-90 percent open space. Pate teaches at col. 5, lines 21-49, the bonding process includes the steps of the selection of the thickness of the film as well as embossing, heating and pressing to make the thermoplastic resin flow and to form apertures. At col. 6, Pate teaches that the total apertured area of the laminate is from 10-30 percent. Therefore, Pate teaches that the process of bonding also forms an apertured and breathable film layer. Pate teaches that the opening area of the fabric is greater than the open area of the final laminate, (which comprises the film layer). Pate does not teach a random process but one in which the film thickness, embossing

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pattern, temperature and pressure are controlled with the purpose of producing an apertured film. The person of ordinary skill in the art would be able to control temperatures, pressure, time, film thickness and embossing pattern in order to control the degree of flow and therefore, the openings formed.

5. Applicant argues that in the instant claims, the apertures are formed by needle punching during lamination. However, this limitation is not present in the claims. As set forth above, Pate teaches forming a breathable laminate by laminating a continuous film with a fabric having an open area of from 40-90 percent and selecting film thickness as well as processing conditions to form an apertured film and a final laminate which has an open area of from less than 10-30 percent. Pate clearly teaches controlling the process to form the openings, because it is also well known in the art to bond films and fabrics so that the film layer remains continuous.

6. With regard to the showing in the specification set forth in Table 6, the showing is not commensurate in scope with the claims because it does not include values from across the claimed range of opening sizes and does not compare those values with values which are outside the claimed range. The table does not establish the criticality of the claimed opening size range.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

e.m.c